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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/331,959 09/28/99 DUBOUIS

R 022701-831

021839 IM62/0313
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POST OFFICE BOX 1404
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EXAMINER

MOORE, M

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 03/13/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/331,959

Applicant(s)
Dubouis et al.

Examiner
Margaret Glass Moore

Group Art Unit
1712



☒ Responsive to communication(s) filed on Dec 27, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1 to 13 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1 to 13 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. Claims 2 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2:

This rejection is maintained for reasons of record. While applicants state that the MPEP does not require applicant to recite alternative language in Markush form, it does ^{clearly} ~~clear~~ state that "when materials recited in a claim are so related as to constitute a proper Markush group, they may be recited in the conventional manner, or alternatively. For example, if "wherein R is a material selected from the group consisting of A, B, C and D" is a proper limitation, then "wherein R is A, B, C or D" shall also be considered proper." The phrase "the group of..." is confusing since 1) it is unclear if this group is closed or open (note that "selected from the group consisting of" clearly indicates a closed group) and 2) it is not clear what the group contains.

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Claim 6:

This rejection is also maintained from the previous office action, as it is quite confusing what is embraced by this claim. Note that "the definitions with regard to polyorganosiloxane..." is confusing since one does not know what these definitions are. For instance, reference to "this time" makes no sense since it is unclear what constitutes any other time.

2. For the record, the Examiner notes that the phrase "either crosslinkable at room temperature or with the heat from polyaddition reactions in the presence of a platinum catalyst" does not require the composition to actually be room temperature crosslinked or crosslinked ^{with heat} ~~from~~ a polyaddition reaction in the presence of a platinum catalyst, only that the composition be able to be crosslinked in such a manner. This is a significant difference; just because a composition is able to be crosslinked in a particular way does not mean the reference has to refer to this.

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3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1 to 3 and 8 to 12 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 50 97644, herein '644. This document was made of record in the office action dated 10/5/00.

'644 teaches a silicone rubber composition. Note the top of page 2 which teaches a composition containing the mixture A, containing A1 and A3. Both D and E are present in an amount which meets that required by claim 1. Particular attention is drawn to Application Example 1. While this composition does not crosslink from a polyaddition reaction in the presence of a platinum catalyst, the Examiner notes that it contains Si bonded vinyl groups which are known to undergo addition reaction crosslinking when admixed with SiH containing compounds and a platinum catalyst. Thus, though this composition does not crosslink by a polyaddition reaction in the presence of a platinum catalyst, this composition is *able* to crosslink in such a manner, thereby anticipating the limitation of claim 1.

With regards to claim 11, while this reference is silent as to enhanced arc tracking and arc erosion, this will inherently be met by the composition of '644 since it teaches making an article

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with the same composition as that recited in instant claim 1. The enhanced arc tracking and arc erosion will inherently be met by the method of making an article in '644 since the composition contains the arc tracking and arc erosion enhancing components in what is disclosed by applicants as an effective amount.

6. Claims 4 to 7 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over '644 in view of Matsushita ~~et al.~~.

These claims require that the polyorganosiloxane composition in claim 1 contain, in addition to a Si-vinyl siloxane, an Si-H component and a catalytically effective amount of a Pt catalyst. '644 fails to teach such a composition.

Matsushita teaches a silicone rubber composition which is an improvement over '644. This reference teaches that either peroxide cured gums can be used, or lower viscosity siloxanes that crosslink through SiH components in the presence of a catalytically effective amount of a Pt catalyst. See for instance Example 1 and 2, which peroxide polymerize silicone "rubbers", similar to that used in '644, and Example 3, which uses a lower viscosity siloxane in an addition reaction. Note too column 2, which teaches the vinyl containing siloxane, and the bottom of column 4 through column 5, which teaches the alternative use of peroxide and SiH/platinum curing compositions. Both compositions are used to form silicone rubber end products, and thus Matsushita indicates that such compositions can be used alternatively and equivalently in the formation of self extinguishing silicone rubbers.

Thus one having ordinary skill in the art would have been motivated by the teachings of Matsushita to use silicone rubber forming components such as those required by claims 4 to 7 in the silicone rubber forming composition of '644 with a reasonable expectation of success. As such these claims would appear to have been obvious to the skilled artisan in view of the totality of the teachings in these prior art references.

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7. Claims 1 to 3, 8, 9, 11 and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Takita et al.

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8. Claims 4 to 7, 10 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takita et al.

The Examiner relies on the rationale for both of these rejections as detailed in the previous office actions. In applicants' remarks, they traverse these rejections, but this is not persuasive. While Takita et al. teach peroxide curable compositions, they also teach that the compositions can be cured at elevated temperature with SiH crosslinking components. This is a polyaddition reaction. Thus, the compositions taught by Takita et al. meet the "crosslinkable by..." limitation as now found in claim 1.

9. Any inquiry concerning this communication should be directed to Margaret G. Moore at telephone number (703) 308-4334.

Any **official** documents (after final rejection) can be faxed to (703) 872-9310. All other **official** faxes should be sent to (703) 872-9311. Please do not send any informal communication or proposed amendments to this number.


Margaret G. Moore
Primary Examiner
Art Unit 1712

mgm
March 9, 2001